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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,134	11/01/2000	Todd Siegel	00688081	4080
33448	7590	04/19/2005	EXAMINER	
ROBERT J. DEPKE LEWIS T. STEADMAN TREXLER, BUSHNELL, GLANGLORGI, BLACKSTONE & MARR, 105 WEST ADAMS STREET SUITE 3600 CHICAGO, IL 60603-6299			PARADISO, JOHN ROGER	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Sp

<b>Office Action Summary</b>	<b>Application No.</b> 09/704,134	<b>Applicant(s)</b> SIEGEL ET AL.	
	<b>Examiner</b> John R Paradiso	<b>Art Unit</b> 3721	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Request for Continued Examination*

1. The request filed on 4/4/2005 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/734,134 is acceptable and a CPA has been established. An action on the CPA is attached.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over TAKEMASA ET AL (US 5765606) in view of BOUTHINETTE (US 6023916) and HAYES ET AL (US 6334980).

4. TAKEMASA ET AL discloses an automated pharmaceutical packaging machine in which pharmaceutical products are dispensed from an array of sources (7) to a corresponding funnel (33) (See Figure 8) and then into each cavity of a plurality of product package cavities (33) and transferring them into a product package member. (See TAKEMASA ET AL columns 4 and 5 and figure 6)

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5. TAKEMASA ET AL does not specifically disclose the pharmaceutical products being dispensed into product package templates.
6. BOUTHINETTE discloses a packaging kit with product package template cavities corresponding to cavities of a product package member. (See BOUTHINETTE columns 5 and 6 and figures 2, 7, and 11.)
7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of TAKEMASA ET AL by dispensing the pharmaceutical products into product package templates, as taught by BOUTHINETTE, in order to ensure facilitated product placement into popular compartmented containers.
8. The combination of TAKEMASA ET AL and BOUTHINETTE does not disclose the use of an X-Y mechanical drive to move the package templates.
9. HAYES ET AL discloses an apparatus in which a dispensing apparatus (602a-c) which dispenses specific quantities of fluid to specific places on a template (722) which is moved by an X-Y positioning table (606). An X-Y circuit (608) moves the positioning table so that the correct spots in the template are positioned under the correct dispensers. (See HAYES ET AL column 11 line 38 to column 12 line 19 and figure 9.)
10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the X-Y positioning table, as taught by HAYES ET AL, in the combination of TAKEMASA ET AL and BOUTHINETTE in order to more accurately place the products.

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11. Regarding claims 2 and 7, Applicant is given Official Notice that the use of pneumatic cylinders for movement of machine assemblies is notoriously well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use pneumatic cylinders to move the parts of the combination of KNUDSEN, BOUTHINETTE, and HAYES ET AL in order to move the assemblies in an easily controllable manner.

12. Regarding claims 3 and 8, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the combination of KNUDSEN, BOUTHINETTE, and HAYES ET AL with any number of arrays and funnels, as determined to be most efficient, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233

#### ***Response to Arguments***

13. Applicant's arguments filed 4/4/2005 have been fully considered but they are not persuasive.

14. Applicant states on page 5 of his Response that "None of the references cited by the Examiner is directed to selectively filling a two-dimensional array by selectively locating a funnel through which one or more solid products may pass into a product package template."

However, TAKEMASA ET AL clearly shows this feature. (See TAKEMASA ET AL, Figures 2, 6, and 9)

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***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.



Examiner John Paradiso: (571) 272-4466

April 18, 2005

**Additional Phone Numbers:**

Supervisor Rinaldi Rada: (571) 308-7135

Fax (Official): (703) 872-9306

Fax (Direct to Examiner) (571) 273-4466 (Drafts only)